

REMARKS

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

Claims 1, 7, 8, and 17 have been amended as shown above. Because these amendments place Claims 1, 7, 8, and 17 in better condition for allowance or appeal, these amendments comply with 37 C.F.R. § 1.116.

Claims 1-20 remain in this application.

Reconsideration and full allowance of Claims 1-20 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 112

The Office Action rejects Claims 1-20 under 35 U.S.C. § 112, first paragraph, for failing to satisfy the written description requirement.

The Applicants previously amended Claims 1, 8, and 17 to recite the states in which a mobile station operates. The Office Action notes that these amendments do not place the claims in condition for allowance. The Applicants have therefore amended Claims 1, 8, and 17 to remove the previously added elements.

The deleted portions of Claims 1, 8, and 17 formed the basis of the § 112 rejection. As a result, the amendments to Claims 1, 8, and 17 overcome this rejection. Accordingly, the Applicants respectfully request withdrawal of the § 112 rejection.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 3-7, and 17-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,085,085 to Blakeney, II et al. ("*Blakeney*") in view of U.S. Patent No. 6,021,328 to Curtis et al. ("*Curtis*") and U.S. Patent No. 6,188,897 to Nelson ("*Nelson*"). The Office Action rejects Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over *Blakeney*, *Curtis*, and *Nelson* in view of U.S. Patent No. 5,548,818 to Sawyer et al. ("*Sawyer*"). The Office Action rejects Claims 8-10 and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over *Sawyer* in view of *Curtis* and *Nelson*. The Office Action rejects Claims 11-13 under 35 U.S.C. § 103(a) as being unpatentable over *Sawyer*, *Curtis*, and *Nelson* in view of *Blakeney*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant

of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142.

Blakeney recites a method and apparatus for selecting a communication system based on the geographic region in which a mobile telephone is located. (*Abstract*). The mobile telephone first selects and attempts to establish a connection with an initial communication system. (*Figure 2A*). Once a connection has been established, the mobile telephone identifies the geographic region in which the telephone is located. (*Abstract*). Once its location is determined, the mobile telephone determines whether a more desirable communication system is available in the identified geographic region and attempts to establish a connection with the most desirable system in the region. (*Figure 2A-2B*).

Blakeney simply recites a mobile telephone that identifies its current location and then identifies the most desirable communication system in that location. *Blakeney* lacks any mention of determining whether a “threshold” number of messages or message signals is received during one or more time periods as recited in Claims 1, 8, and 17. *Blakeney* also lacks any mention of determining an “error rate” associated with the messages or message signals as recited in Claims 1, 8, and 17. *Blakeney* further lacks any mention of accessing another radio system when either the number of messages or message signals does not meet the “threshold” or the error rate exceeds a “threshold value” as recited in Claims 1, 8, and 17.

Curtis recites a method and system for triggering a handoff of a call from one network to another. (*Abstract*). In particular, *Curtis* triggers a handoff of an active call based on an error rate of transmitted and received signals, a gain of the signals, and energy per bit to noise power measurements. (*Col. 2, Lines 52-67*).

Curtis simply recites performing a handoff of an active call between two communication networks. *Curtis* fails to disclose determining whether a “threshold” number of messages or message signals is received during a time period and accessing another radio system when the threshold number is not received as recited in Claims 1, 8, and 17. *Curtis* also fails to disclose determining an “error rate” associated with a plurality of messages “when the threshold number of the messages are received during one or more of the time periods” as recited in Claims 1 and 17.

Nelson recites a method and apparatus for controlling roaming in a multiple service provider environment. (*Abstract*). In particular, *Nelson* monitors the quality of a control channel and prevents

roaming when a mobile station is in a coverage hole that is not near the periphery of a coverage area. (Col. 5, Lines 6-29 and 63-66).

Nelson simply recites how roaming is suppressed when a mobile telephone is not near the periphery of a coverage area. *Nelson* lacks any mention of determining whether a “threshold” number of messages or message signals is received during one or more time periods or accessing another radio system when the threshold is not met as recited in Claims 1, 8, and 17. *Nelson* also fails to disclose determining an “error rate” associated with a plurality of messages “when the threshold number of the messages are received during one or more of the time periods” as recited in Claims 1 and 17.

Sawyer recites a method and system for radio communications between mobile units and base stations. (*Abstract*). The mobile unit receives salutation beacons from one or more base stations. (Col. 10, Lines 6-10). Before communicating with a base station, the mobile unit counts the number of beacons received and communicates with the base station only after a particular number of beacons (such as five) have been received. (Col. 10, Lines 26-31).

Sawyer simply recites a mobile unit that counts beacons and communicates with a base station after five beacons have been received. *Sawyer* fails to disclose determining an “error rate” associated with a plurality of messages “when the threshold number of the messages are received during one or more of the time periods” as recited in Claims 1 and 17. *Sawyer* also lacks any mention of accessing another radio system when the number of message signals received within a predetermined time period “meets [a] first threshold value” but an “error rate associated with said

message signals exceeds a second threshold value” as recited in Claim 8.

Moreover, there is no motivation to combine *Sawyer* with any of the other cited references. *Sawyer* notes that it is “virtually impossible” for a single network to acquire the same frequency allocation to provide nationwide coverage. (*Col. 1, Lines 61-67*). *Sawyer* also notes that one exception is the cellular phone system. (*Col. 2, Lines 1-2*). *Sawyer* goes on to describe a system where RF equipment may roam into different geographic regions, even though the regions include base stations that operate using different frequency allocations. (*Col. 3, Lines 36-40*).

Sawyer is specifically designed for use in systems where base stations in different regions use different frequency allocations. *Sawyer* specifically notes that this does not include cellular phone systems, which “benefit from consistent nationwide frequency allocations.” (*Col. 2, Lines 3-6*). As a result, it would not be obvious to combine *Sawyer* with any of *Blakeney*, *Curtis*, and *Nelson* (all of which describe mobile telephone systems).

The cited references fail to disclose, teach, or suggest all elements of Claims 1, 8, and 17 (and their dependent claims). For these reasons, the Office Action fails to establish a *prima facie* case of obviousness regarding Claims 1-20. Accordingly, the Applicants respectfully request withdrawal of the § 103(a) rejection and full allowance of Claims 1-20.

III. CONCLUSION

For the reasons given above, the Applicants respectfully request reconsideration and full allowance of all pending claims and that this application be passed to issue.

SUMMARY

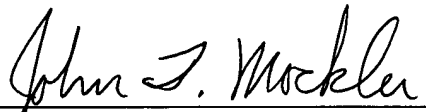
If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@davismunck.com*.

No fees are believed to be necessary for the prosecution of this application. If any fees are necessary, however, please charge the fees to Deposit Account No. 50-0208. No extension of time is believed to be necessary. If an extension of time is needed, however, the extension is requested. Please charge the fee for the extension to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 12 August 2003



John T. Mockler
Registration No. 39,775

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *jmockler@davismunck.com*